

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Helen Ann BIDDISCOMBE :
Serial No.: 09/960,368 : Group Art Unit: 1771
Filed: Sept. 24, 2001 : Examiner: D.R. Zirker
For: Polymeric Films :

#6
3-14-03
JProck

TERMINAL DISCLAIMER

Assistant Commissioner of Patents
Washington, D.C. 20231

RECEIVED
MAR -4 2003
TO 1700 MAIL ROOM

Sir:

I, Joseph DeBenedictis, represent that I am the attorney of record for the above-identified application and the present invention.

Trespaphan GmbH (henceforth referred to as "Assignee") is the owner of the entire right and title to U.S. patent no. 6,306,490 and the invention and improvements therein disclosed for the United States, by virtue of an assignment from the inventor to Hoechst Trespaphan GmbH dated January 8, 1998, and recorded at Reel 8960, Frame 0253 on January 16, 1998, and by virtue of a change of name of Hoechst Trespaphan GmbH to Trespaphan GmbH dated February 13, 2001, and recorded on October 30, 2001 at Reel 012287, Frame 0458. Assignee is also owner of the entire right and title to the above-captioned application and the invention and improvements therein disclosed for the United States, by virtue of the same assignment and change of name.

The terminal part of any patent granted on the above-captioned application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,306,490 as presently shortened by any terminal disclaimer is hereby disclaimed. Any patent granted on the above-captioned application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to the U.S. Patent No. 6,306,490; this agreement to run with any patent granted on the above-captioned application and to be binding upon the grantee, its successors or assigns. However, no rights available under the provisions of 35 U.S.C. §§ 155 and 156 are hereby waived.


Serial No. 09/412,610

No terminal part is disclaimed of any patent granted on the above-captioned application prior to the expiration date of the full statutory term of the U.S. Patent No. 6,306,490 as presently shortened by any terminal disclaimer in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term, except for the separation of legal title stated above.

The Terminal Disclaimer fee of \$110.00 is submitted herewith. Please charge any additional fees or credit any overpayments in connection with this paper to Deposit Account No. 02-0200. A duplicate copy of this paper is enclosed.

Date: February 25, 2003

Respectfully submitted,


Joseph DeBenedictis
Registration No. 28,502
Attorney of Record

BACON & THOMAS

625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314
(703) 683-0500

S:\Producer\jdb\TRESPAPHAN GMBH\Biddiscombe 960368\terminal disclaimer.wpd

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 3-14-03

APPL. S.N.: 09/969368

EXAMINER: _____

ART UNIT: 1771

PARALEGAL: JEAN PROCTOR

MAILROOM DATE: 2-25-03

AFTER FINAL: YES ___ NO ✓

NUMBER OF T.D.(S) FILED: 1

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

☒ The T. D. is PROPER and has been recorded. (See 14.23)

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)

☐ Application Examiner has not processed fee for T. D.

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)

☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)

☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)

☐ is not recognized as an officer of the assignee. (See 14.29.1)

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)

☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)

☐ The T. D. is not signed (See 14.26 and 14.26.3)

☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)

☐ Other _____